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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/900,543	07/06/2001	Philip Shi-Lung Yu	I01.043	5044
48175	7590	10/05/2005	EXAMINER	
BMT/IBM FIVE ELM STREET NEW CANAAN, CT 06840			NAJARIAN, LENA	
			ART UNIT	PAPER NUMBER
			3626	
DATE MAILED: 10/05/2005				

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/900,543

Applicant(s)

YU ET AL.

Examiner

Lena Najarian

Art Unit

3626

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 06 July 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-37 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-37 is/are rejected.
- 7) ☒ Claim(s) 25 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 20010706.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date: _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Claim Objections

1. Claim 25 is objected to because of the following informalities: there is a typographical error at the end of line 2. The Examiner requests that Applicant remove the following: "; and". Appropriate correction is required.

Claim Rejections - 35 USC § 101

2. Claims 1-3 and 5-35 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

The basis of this rejection is set forth in a two-prong test of:

- (1) whether the invention is within the technological arts; and
- (2) whether the invention produces a useful, concrete, and tangible result.

For a claimed invention to be statutory, the claimed invention must be within the technological arts. Mere ideas in the abstract (i.e., abstract idea, law of nature, natural phenomena) that do not apply, involve, use, or advance the technological arts fail to promote the "progress of science and the useful arts" (i.e., the physical sciences as opposed to social sciences, for example) and therefore are found to be non-statutory subject matter. For a process claim to pass muster, the recited process must somehow apply, involve, use, or advance the technological arts.

(A) In the present case, claims 1- 3 and 5-15 only recite an abstract idea. The recited steps of exemplary claim 1 of merely determining an address for a location where information regarding a product is available, providing data indicative of said address to

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an entity that can provide said product, receiving information regarding a recipient of said product, and updating said information regarding said product does not apply, involve, use, or advance the technological arts since all of the recited steps can be performed in the mind of the user or by use of a pencil and paper.

Additionally, for a claimed invention to be statutory, the claimed invention must produce a useful, concrete, and tangible result. In the present case, the claimed invention provides information regarding a product. Although the recited process produces a useful, concrete, and tangible result, since the claimed invention, as a whole, is not within the technological arts as explained above, claims 1-3 and 5-15 are deemed to be directed to non-statutory subject matter.

(B) In the present case, claims 16-21 only recite an abstract idea. The recited steps of exemplary claim 16 of merely determining an address for a location, wherein information regarding a product available via a prescription can be found at said location without additional routing, receiving a prescription to provide said product to a recipient, creating packaging for said product that includes said address, and providing said product with said packaging does not apply, involve, use, or advance the technological arts since all of the recited steps can be performed in the mind of the user or by use of a pencil and paper.

Additionally, for a claimed invention to be statutory, the claimed invention must produce a useful, concrete, and tangible result. In the present case, the claimed invention provides information regarding a product. Although the recited process produces a useful, concrete, and tangible result, since the claimed invention, as a

whole, is not within the technological arts as explained above, claims 16-21 are deemed to be directed to non-statutory subject matter.

(C) In the present case, claims 22-26 only recite an abstract idea. The recited steps of exemplary claim 22 of merely determining an address for a location, wherein information regarding a product can be found at said location without additional routing and providing data indicative of said address to an entity that can provide said product does not apply, involve, use, or advance the technological arts since all of the recited steps can be performed in the mind of the user or by use of a pencil and paper.

Additionally, for a claimed invention to be statutory, the claimed invention must produce a useful, concrete, and tangible result. In the present case, the claimed invention provides information regarding a product. Although the recited process produces a useful, concrete, and tangible result, since the claimed invention, as a whole, is not within the technological arts as explained above, claims 22-26 are deemed to be directed to non-statutory subject matter.

(D) In the present case, claims 27-35 only recite an abstract idea. The recited steps of exemplary claim 27 of merely establishing a location for information regarding a person, allowing said person to partition access to said information, receiving a request to provide access to a portion of said information to a party, and providing access to said portion of said information by said party if such access is authorized does not apply, involve, use, or advance the technological arts since all of the recited steps can be performed in the mind of the user or by use of a pencil and paper.

Additionally, for a claimed invention to be statutory, the claimed invention must produce a useful, concrete, and tangible result. In the present case, the claimed invention provides information regarding a product. Although the recited process produces a useful, concrete, and tangible result, since the claimed invention, as a whole, is not within the technological arts as explained above, claims 27-35 are deemed to be directed to non-statutory subject matter.

(E) Regarding claim 37, the Examiner interprets the instructions of the "computer program product in a computer readable medium" recited in the claim to be executed on a computer. As such, the claim is statutory.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

4. Claims 1-6, 8-15, and 22-37 are rejected under 35 U.S.C. 102(e) as being anticipated by Abreu (US 2001/0056359 A1).

(A) Referring to claim 1, Abreu discloses a method for providing information regarding a product, comprising (see abstract of Abreu):

determining an address for a location where information regarding a product is available (para. 29 of Abreu);

providing data indicative of said address to an entity that can provide said product (para. 27 and para. 159 of Abreu);

receiving information regarding a recipient of said product (para. 246 of Abreu);
and

updating said information regarding said product based, at least in part, on said information regarding a recipient (para. 223 of Abreu).

(B) Referring to claim 2, Abreu discloses wherein said determining an address for a location where information regarding a product is available includes at least one of the following: associating a URL with said location; determining a link to said information; associating a telephone number with said location; determining a World Wide Web site at which the information can be found; determining a database at which the information can be found; receiving data indicative of said address and said location; and selecting said address from among a plurality of available addresses (para. 309 of Abreu).

(C) Referring to claim 3, Abreu discloses wherein said providing data indicative of said address to an entity that can provide said product includes at least one of the following: sending an electronic communication including said data to said entity; and allowing said entity to retrieve said data (para. 27 of Abreu).

(D) Referring to claims 4 and 5, Abreu discloses wherein said receiving information regarding a recipient of said product includes receiving an electronic communication from said recipient, said electronic communication including at least a portion of said

information regarding a recipient of said product (para. 228 of Abreu) and wherein said updating said information regarding said product based, at least in part, on said information regarding a recipient includes receiving information regarding use of said product from said recipient and updating said information regarding said product accordingly (para. 223 and para. 256 of Abreu).

Insofar as the claim recites "at least one of," it is immaterial whether or not the other elements are also disclosed.

(E) Referring to claim 6, Abreu discloses wherein each of a plurality of recipients of said product can receive a unique address to a location where information regarding said product is available (para. 309 of Abreu).

(F) Referring to claims 8 and 9, Abreu discloses wherein said product is available via prescription and wherein said product is a drug (para. 127 and para. 133 of Abreu).

(G) Referring to claim 10, Abreu discloses wherein said location includes at least one of the following: a call center; a Web page; and a database (para. 309 of Abreu).

(H) Referring to claim 11, Abreu discloses wherein said address includes at least one of the following: a telephone number; and a URL (para. 309 of Abreu).

(I) Referring to claim 12, Abreu discloses wherein said information includes information regarding use of said product (para. 292 of Abreu). Insofar as the claim recites "at least one of," it is immaterial whether or not the other elements are also disclosed.

(J) Referring to claim 13, Abreu discloses wherein said product is a drug and said information includes information regarding use of said product (para. 292 of Abreu).

Insofar as the claim recites "at least one of," it is immaterial whether or not the other elements are also disclosed.

(K) Referring to claim 14, Abreu discloses receiving information regarding use of said product from said recipient (para. 292 of Abreu). Insofar as the claim recites "at least one of," it is immaterial whether or not the other elements are also disclosed.

(L) Referring to claim 15, Abreu discloses establishing said location (para. 309 of Abreu).

(M) Referring to claim 22, Abreu discloses a method for providing information regarding a product, comprising (see abstract of Abreu):

determining an address for a location, wherein information regarding a product can be found at said location without additional routing (para. 309 of Abreu); and
providing data indicative of said address to an entity that can provide said product (para. 27 and para. 159 of Abreu).

(N) Referring to claim 23, Abreu discloses receiving information regarding use of said product from said recipient (para. 292 of Abreu). Insofar as the claim recites "at least one of," it is immaterial whether or not the other elements are also disclosed.

(O) Referring to claim 24, Abreu discloses wherein said product is available by prescription (para. 127 of Abreu).

(P) Referring to claim 25, Abreu discloses receiving information regarding a recipient of said product (para. 246 of Abreu).

(Q) Referring to claim 26, Abreu discloses updating said information regarding said product based, at least in part, on said recipient (para. 223 of Abreu).

(R) Referring to claim 27, Abreu discloses a method for providing information regarding a product, comprising (see abstract of Abreu):

establishing a location for information regarding a person (para. 255 of Abreu);

allowing said person to partition access to said information; receiving a request to provide access to a portion of said information to a party; and providing access to said portion of said information by said party if such access is authorized (para. 143 and para. 303 of Abreu).

(S) Referring to claim 28, Abreu discloses wherein said establishing a location for information regarding a person includes at least one of the following: establishing a Web page that includes said information; determining a link to a Web page that includes said information; establishing a secure database that includes said information; and establishing a telephone number with which said information can be retrieved (para. 309 of Abreu).

(T) Referring to claim 29, Abreu discloses wherein said allowing said person to partition access to said information includes allowing said person to control access to all of said information; allowing said person to allow access by another party to a portion of said information during a time period established by said person (para. 303 of Abreu).

Insofar as the claim recites "at least one of," it is immaterial whether or not the other elements are also disclosed.

(U) Referring to claim 30, Abreu discloses wherein said allowing said person to partition access to said information includes allowing said person to grant an ability to at least one other person to access said information (para. 303 of Abreu). Insofar as the claim

recites "at least one of," it is immaterial whether or not the other elements are also disclosed.

(V) Referring to claim 31, Abreu discloses wherein said receiving a request to provide access to a portion of said information to a party includes at least one of the following: receiving an electronic communication containing said request; receiving said request from said person; and receiving said request from said party (para. 132 of Abreu).

(W) Referring to claim 32, Abreu discloses wherein said providing access to said portion of said information by said party if such access is authorized includes allowing said party to retrieve said portion of information (para. 142 of Abreu). Insofar as the claim recites "at least one of," it is immaterial whether or not the other elements are also disclosed.

(X) Referring to claim 33, Abreu discloses providing a notification to said person when access to any portion of said information is granted (para. 142 of Abreu).

(Y) Referring to claim 34, Abreu discloses determining if said party is authorized to access said portion of said information (para. 302 of Abreu).

(Z) Referring to claim 35, Abreu discloses wherein said request includes a password that allows access to said portion of information (para. 302 of Abreu). Insofar as the claim recites "at least one of," it is immaterial whether or not the other elements are also disclosed.

(AA) Referring to claim 36, Abreu discloses a system for providing information regarding a product, comprising (see abstract of Abreu):

a memory; a communication port; and a processor connected to said memory and said communication port, said processor being operative to (Fig. 9, Fig. 5A, and para. 112 of Abreu):

determine an address for a location where information regarding a product is available (para. 29 of Abreu);

provide data indicative of said address to an entity that can provide said product (para. 27 and para. 159 of Abreu);

receive information regarding a recipient of said product (para. 246 of Abreu);
and

update said information regarding said product based, at least in part, on said information regarding a recipient (para. 223 of Abreu).

(BB) Referring to claim 37, Abreu discloses a computer program product in a computer readable medium for providing information regarding a product, comprising (see abstract and para. 38 of Abreu):

first instructions for identifying an address for a location where information regarding a product is available (para. 29 of Abreu);

second instructions for sending a notification indicative of said address to an entity that can provide said product (para. 27 and para. 159 of Abreu);

third instructions for obtaining information regarding a recipient of said product (para. 246 of Abreu); and

fourth instructions for revising said information regarding said product based, at least in part, on said information regarding a recipient (para. 223 of Abreu).

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 7 and 16-21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Abreu (US 2001/0056359 A1) in view of De La Huerga (US 2001/0028308 A1).

(A) Referring to claim 7, Abreu does not expressly disclose wherein said entity can include said address on packaging associated with said product.

De La Huerga discloses wherein said entity can include said address on packaging associated with said product (Fig. 29, Fig. 51, and para. 405 of De La Huerga).

At the time of the invention, it would have been obvious to a person of ordinary skill in the art to combine the feature of De La Huerga within Abreu. The motivation for doing so would have been to identify a location for reordering medication (para. 405 of De La Huerga).

(B) Referring to claim 16, Abreu discloses a method for providing information regarding a product, comprising (see abstract of Abreu):

determining an address for a location, wherein information regarding a product available via a prescription can be found at said location without additional routing and

receiving a prescription to provide said product to a recipient (para. 309 and para. 127 of Abreu);

Abreu does not expressly disclose creating packaging for said product that includes said address and providing said product with said packaging.

De La Huerga discloses creating packaging for said product that includes said address and providing said product with said packaging (Fig. 29, Fig. 51, and para. 405 of De La Huerga).

At the time of the invention, it would have been obvious to a person of ordinary skill in the art to combine the feature of De La Huerga within Abreu. The motivation for doing so would have been to identify a location for reordering medication (para. 405 of De La Huerga).

(C) Referring to claim 17, Abreu discloses wherein said determining an address for a location, wherein information regarding a product available via a prescription can be found at said location without additional routing includes associating a URL with said location (para. 309 of Abreu). Insofar as the claim recites "at least one of," it is immaterial whether or not the other elements are also disclosed.

(D) Referring to claim 18, Abreu discloses wherein said receiving a prescription to provide said product to a recipient includes receiving data indicative of said prescription (para. 127 of Abreu). Insofar as the claim recites "at least one of," it is immaterial whether or not the other elements are also disclosed.

(E) Referring to claim 19, Abreu does not expressly disclose wherein said creating packaging for said product that includes said address includes at least one of the

following: providing a label on a container of said product, said label including said address; and providing said address on a container of said product.

De La Huerga discloses wherein said creating packaging for said product that includes said address includes at least one of the following: providing a label on a container of said product, said label including said address; and providing said address on a container of said product (Fig. 29, Fig. 51, and para. 405 of De La Huerga).

At the time of the invention, it would have been obvious to a person of ordinary skill in the art to combine the feature of De La Huerga within Abreu. The motivation for doing so would have been to identify a location for reordering medication (para. 405 of De La Huerga).

(F) Referring to claim 20, Abreu discloses wherein said providing said product with said packaging includes distributing said product in said packaging (para. 123 of Abreu). Insofar as the claim recites "at least one of," it is immaterial whether or not the other elements are also disclosed.

(G) Referring to claim 21, Abreu discloses establishing said location (para. 309 of Abreu).

Conclusion

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Lena Najarian whose telephone number is 571-272-7072. The examiner can normally be reached on Monday - Friday, 8:30 am - 5:00 pm.

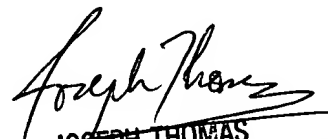
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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph Thomas can be reached on 571-272-6776. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Ln

In
9-30-05


JOSEPH THOMAS
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 3600